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| APPLICATION NO.                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/829,005                             | 04/21/2004  | Myron L. Munn        |                     | 5504             |
| 31083                                  | 7590        | 01/18/2007           | EXAMINER            |                  |
| THOMTE, MAZOUR & NIEBERGALL, L.L.C.    |             |                      | KURTZ, BENJAMIN M   |                  |
| 2120 S. 72ND STREET, SUITE 1111        |             |                      | ART UNIT            | PAPER NUMBER     |
| OMAHA, NE 68124                        |             |                      | 1723                |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE |             | MAIL DATE            | DELIVERY MODE       |                  |
| 3 MONTHS                               |             | 01/18/2007           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                 |                |
|------------------------------|-----------------|----------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |
|                              | 10/829,005      | MUNN, MYRON L. |
| Examiner                     | Art Unit        |                |
| Benjamin Kurtz               | 1723            |                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 November 2006.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*; 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 4-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 4-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 April 1940 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the adapter" in line 10 and "the oil filter adapter" in line 18. There is insufficient antecedent basis for this limitation in the claim. For examination purposes claim 4 is taken to claim "An oil filter adapter for..."

Claims 5-8 contain the same defect as they depend therefrom.

### ***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sparling US 5 766 451. Regarding claim 4, Sparling teaches an oil filter adapter comprising: a disc-shaped adapter member (10) having an engine side and a filter side, said engine side having an annular o-ring (36) in a groove (38), the o-ring has the same diameter of a standard canister o-ring, the adapter member has an internally threaded central opening (20) formed therein which extends inwardly from said engine side thereof which is adapted to threadably receive an externally threaded filtered oil tube of the oil filter receptacle, said adapter member having an externally threaded, hollow nipple (40) extending from its said filter side at the center thereof which is in communication with the interior of said internally threaded central opening in the adapter member, the threads of the hollow nipple matches the threads of the oil outlet of the replacement oil filter canister (48), the adapter member having a plurality of spaced apart unfiltered oil passageways (17) formed therein which extend therethrough from said engine side to said filter side thereof outwardly of said central opening of said adapter member, the filter side of the adapter member having an annular seat (26) formed thereon which is positioned outwardly of said hollow nipple and said unfiltered oil passageway thereof, the internally threaded filtered oil outlet of oil filter canister threadably receives said externally threaded hollow nipple whereby the canister o-ring may be drawn into sealing engagement with said annular seat of the adapter member (fig. 3).

Regarding claims 5 and 7, Sparling further teaches the threads of the internally threaded central opening of the adapter member are different than the threads on said

hollow nipple (col. 7, lines 53-59); and the annular seat on said filter side of the adapter member has a width sufficiently large enough to enable replacement oil filter canister o-rings of various diameters to be placed into sealing engagement therewith (fig. 3).

3. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sparling '451. Sparling teaches the threads of the internally threaded central opening of the adapter member are different than the threads on said hollow nipple (col. 7, lines 53-59) but is silent about the internally threaded opening threads are SAE threads and the hollow nipple threads are metric threads. Having different configurations of a filter and its connections would imply such a configuration as taught by Sparling (col. 7, lines 53-59) or in the alternative would be obvious to one of ordinary skill in the art at the time the invention was made because the use of metric and SAE type threads are commonplace in engine connections and oil filters.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sparling '451. Sparling teaches the adapter member of claim 4 but does not teach a one-piece construction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the adapter member and the hollow nipple a one-piece construction because "the use of a one-piece construction...would be merely a matter of obvious engineering choice" *In re Larson*, 144 USPQ 347,349 (1965).

#### ***Response to Arguments***

5. Applicant's arguments filed 11/2/06 have been fully considered but they are not persuasive. The applicant has argued that Sparling cannot anticipate the invention of

claim 4 because the replacement canister of claim 4 has a length greater than the standard oil filter canister and an o-ring of greater diameter than the standard canister o-ring. The invention as claimed is directed to an oil filter adapter and not the size and shape of the canisters to which it is attached. The adapter of Sparling contains all the claimed features and limitations of the present claimed invention of an adapter.

The Smith '169 reference is not used in the present rejection therefore all arguments regarding Smith are moot.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Kurtz whose telephone number is 571-272-

8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bk 1/13/07

  
W. L. WALKER  
SUPERVISORY PATENT EXAMINER  
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